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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,106	02/16/2001	Martin Sugar	BEIERSDORF 7	3482

7590 12/31/2001

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EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
1619	6

DATE MAILED: 12/31/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/763,106	SUGAR ET AL.
Examiner	Art Unit	
Alycia Berman	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

THE MAILING DATE OF THIS COMMUNICATION IS [REDACTED]

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 26 April 2001 .

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-6 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

1. Receipt is acknowledged of the preliminary amendment and the information disclosure statement filed February 16, 2001. Claims 3-6 have been amended. Claims 1-6 are pending. The International Search Report has been considered.

### *Oath/Declaration*

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The claims are indefinite because it is unclear what Applicant intends to encompass by lauryl ether sulfate. Lauryl ether sulfate is not a known chemical compound. Applicant discloses both sodium lauryl ether sulfate and lauryl ether sulfate

throughout the specification and appears to use these terms interchangeably. Does Applicant intend to claim any lauryl ether sulfate or sodium lauryl ether sulfate?

6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 2 recites the broad recitation "more than 0.5% by weight", and the claim also recites "preferably more than 1.0% by weight, in particular more than 2.0% by weight, very particularly more than 3.0% by weight" which is the narrower statement of the range/limitation.

#### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 3-6 provide for the use of one or more anionic surfactants, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 3-6 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 229 690 A2 (690).

EP '690 is directed to cleaning compositions for hair. The compositions contain an alkyl sulfate or alkyl sulfonate surfactant, a betaine surfactant, a sarcosinate surfactant (N-acylamino acid salt) and water (page 2, line 55 to page 3, line 45). The amount of sarcosinate surfactant in the compositions is from about 0.5-15% (page 3, lines 35-36). The compositions may further contain conventional optional components such as sodium chloride and sodium sulfate (inorganic salts). See page 3, lines 45-59. The examples all contain ammonium laureth sulfate, sodium lauroyl sarcosinate and sodium phosphate. See also the claims for N-acylsarcosinates and alkyl sulfate surfactants.

11. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 256 656 A1 (656)

EP '656 is directed to liquid detergent compositions that contain taurate surfactants, sarcosinate surfactants and another auxiliary surfactant (abstract). For sodium lauryl ether sulfate as the auxiliary surfactant, see column 4, lines 1-20. The total amount of surfactant in the composition is about 2-40% and the amount of auxiliary surfactant is about 1-30%. Therefore, the amount of N-acylamino acid surfactant in the composition can be from about 1-39%. Additional optional conventional components that may be added to the compositions are disclosed at column 4, line 50 to column 5, line 28. For inorganic salts, see sodium chloride and sodium sulfate at column 5, line 6. The example at column 6 contains 10% sodium laureth sulfate, 1,8% sodium

methylcocoyl taurate, 2.25% sodium lauroyl sarcosinate and 0.3% sodium chloride, *inter alia*.

12. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 95/02388 (388).

WO '388 is directed to shampoos containing about 5-29.5 wt.% of an alkyl ethoxylated sulfate and about 0.5-5 wt.% of an N-acylamino acid or salt surfactant (abstract). Additional components that may be included in the shampoo compositions include sodium chloride and sodium sulfate (page 33, line 25 to page 34, line 2). See the examples at pages 35-37 for compositions containing sodium laureth sulfate, sodium lauryl sarcosinate and an inorganic salt.

13. The claims as written do not require an inorganic acid. The phrase "up to" includes zero as a lower limit. *In re Mochel*, 470 F2d. 638, 176 USPQ 194 (CCPA 1974).

#### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached during core hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3704 or 703-305-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alycia Berman  
Patent Examiner  
December 19, 2001

  
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